

DAZ

Appl. No. : 09/960,638
 Confirmation No. : 5209
 Applicant : Michael A. Pikula, et al.
 Filed : September 21, 2001
 Title : WIRELESS SYNCHRONOUS
 TIME SYSTEM
 TC/A.U. : 2841
 Examiner : Vit W. Miska
 Docket No. : 077017-9006-00

I, Mary A. Hietpas, hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date of my signature.

Mary A. Hietpas
 Signature

June 24, 2004
 Date of Signature

Mail Stop ISSUE FEE
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

**APPLICATION FOR PATENT TERM ADJUSTMENT
 UNDER 37 C.F.R. §1.705(b)**

Sir:

The Applicants respectfully submit that the patent term adjustment calculated by the U.S. Patent and Trademark Office ("the Office") and indicated in the Notice of Allowance for the above-identified patent application ("the Application") is inaccurate and should be corrected from 110 days to 131 days for the reasons set forth below. The issue fee for the Application has not been paid as of the mailing of this correspondence, therefore the application for patent term adjustment is filed within time period as set forth under 37 C.F.R. §1.705(b). A check for \$200.00 in payment of the fee set forth in 37 C.F.R. §1.18(e) is submitted herewith. Please charge or credit Deposit Account No. 09-0260 with any shortage or overpayment of the fees associated with this communication. The present application is not subject to a terminal disclaimer.

06/29/2004 HGUTEMAZ 00000064 09960638

01 FC:1455

200.00 0P

STATEMENT OF FACTS

The Applicants filed the Application on September 21, 2001. On October 19, 2001, the Applicants received a Notice to File Missing Parts. The Notice to File Missing Parts requested the payment of the filing fee and the filing of the Declaration and Power of Attorney. The

Notice to File Missing Parts also indicated that the drawings filed on September 21, 2001 did not have appropriate margins and requested substitute drawings in compliance with 37 C.F.R. §1.84.

The Applicants responded to the Notice to File Missing Parts by filing the Declaration and Power of Attorney and paying the filing fee. The Office received the response on January 31, 2002.

The Office then issued a Notice of Incomplete Reply on March 25, 2002 for the omission of substitute drawings in the response to the Notice to File Missing Parts. The Notice of Incomplete Reply indicated that the due date for the substitute drawings was the due date specified in the in the Notice to File Missing Parts. The due date for the reply, as stated in the Notice to File Missing Parts, was December 19, 2002, two months from the mailing of the Notice of Incomplete Replay (i.e., October 19, 2001).

The Applicants filed substitute drawings on April 8, 2002 in a response to the Notice of Incomplete Reply. The drawings were received by the Office on April 16, 2002. On May 7, 2002, the Office indicated the Application was complete.

The Office issued a first Non-Final Office action on July 31, 2003. The three month reply period for response to the first Office action expired on October 31, 2003.

The Applicants filed a response to the first Office action on December 1, 2003, which was received by the Office on December 4, 2003. A Notice of Allowance was mailed on March 26, 2004 establishing the due date for the payment of the issue fee and publication fee to be June 28, 2004.

Basis for Patent Term Adjustment under 37 CFR §1.702 and §1.703

The Non-Final Office action was mailed 252 days after November 21, 2002, the date which the fourteen month period specified under 35 U.S.C. §154(b)(1)(A)(i)(I) and 37 C.F.R. §1.702(a)(1) expired. According to 37 C.F.R. §1.703(a)(1), the Application is entitled to patent term adjustment of 252 days.

Basis for Patent Term Reduction under 37 C.F.R. §1.704

When responding to the Notice to File Missing Parts, however, the Applicants failed to engage in reasonable efforts to conclude the prosecution of the patent application. Accordingly, the patent term adjustment for the Application as indicated above is susceptible to a reduction.

As set forth in 37 C.F.R. §1.704(b), a failure to engage in reasonable efforts to conclude the prosecution of a patent application includes any periods of time in excess of three months that are taken to reply to any notice or action by the Office. The three month time period used for reducing a patent term adjustment is applicable regardless of the period of reply that is set forth in the Office notice or action.

Using the three month reply period set forth in 37 C.F.R. §1.704(b) rather than the two month reply period set forth in the Notice to File Missing Parts sets the due date for response to the Notice to File Missing Parts from December 19, 2002 to January 19, 2003. Since the Office received the response on January 31, 2003, 12 days after the three month reply due date set forth in 37 C.F.R. §1.704(b) (i.e., January 19, 2003), the Application is subjected to a 12 day reduction of patent term.

In addition, under 37 C.F.R. §1.704(c)(7), the submission of a reply having an omission is also susceptible to patent term reduction. Since the Applicants' response to the Notice to File Missing Parts lacked substitute drawings, the patent term adjustment for the Application is further is susceptible to a second reduction.

As indicated in 37 C.F.R. §1.704(c)(7), the number of days between the day after the reply having the omission was filed (i.e., February 1, 2003) and the date that the paper correcting the omission was filed (i.e., April 16, 2003) is 75 days and, when added to the previous 12 days of patent term reduction from the delayed response to the Notice of Missing Parts, creates an 87 day patent term reduction.

As stated previously, the Office issued a first Office action on July 31, 2003 having a three month reply period that expired on October 31, 2003. The Applicants filed a response to the first Office action on December 1, 2003. The Office received the response on December 4, 2003, which was 34 days past the three month due date of October 31, 2003. The delayed filing

of the response to the first Office action constitutes another failure to engage in reasonable efforts to conclude prosecution as defined under 37 C.F.R. §1.704(b), and therefore reduces the patent term adjustment by another 34 days.

CONCLUSION

As calculated from the sequence of events described in the STATEMENT OF FACTS section, the Office delayed examination of the patent application by 252 days. Therefore, the patent term for the above-identified patent application should be adjusted by 252 days minus any delays accumulated by the Applicants. The Applicants delays total to 121 days, of which 87 days were accumulated due to the delayed filing of the response to the Notice to File Missing Parts and the response to the Notice of Incomplete Reply and 34 days were accumulated due to the delayed filing of the Applicants' response to the first Office action. Subtracting the Applicants delays from the Office delays generates a 131 day patent term adjustment. As previously stated, the Notice of Allowance mailed on March 26, 2004 indicates a patent term adjustment of 110 days.

The 29 day discrepancy appears to exist between the date that the substitute drawings were filed. According to information recorded on the Patent Application Information Retrieval site (attached as Appendix A) and the return post card that accompanied the substitute drawings (attached as Appendix B), the substitute drawings were received by the Office on April 16, 2002. However, the timer recording the time period for reduction continued until May 7, 2002. Accordingly, the Applicants request that the April 16, 2002 date be used as the ending date for determining the patent term reduction rather than the erroneous date of May 7, 2002.

With the correction of the above date and since the Application is not subject to a terminal disclaimer, a patent term adjustment of 131 days is appropriate. Please correct the indicated patent term adjustment to provide 131 days of patent term adjustment.

The undersigned is available for telephone conference during normal business hours.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Elizabeth A. Egasti', written over the printed name.

Elizabeth A. Egasti

Reg. No. 54,635

Docket No.: 077017-9006-00
Michael Best & Friedrich LLP
100 East Wisconsin Avenue
Milwaukee, Wisconsin 53202-4108
(414) 271-6560



APPENDIX A

A printout of the Patent Term Adjustment History
as shown on the Patent Application Information Retrieval web site

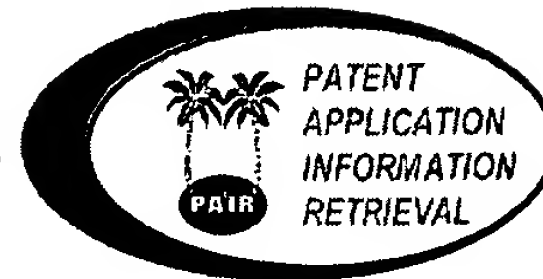


United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)

JUN 28 2004

PATENT APPLICATION INFORMATION RETRIEVAL



Patent Term Adjustment (PTA) for publication number: 09/960,638

			Days
Filing or 371(c) Date:	09-21-2001	USPTO Delay (PTO):	252
Issue Date of Patent:	-	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL):	142
Post-Issue Petitions (days):	+0	Total PTA:	110
USPTO Adjustment (days):	+0	Explanation of Calculations	

Search Options

Assignments
Continuity Data
Image File Wrapper
File History
Publication Review
Published Documents

Patent Term Adjustment History

Date	Contents Description	PTO (days)	APPL (days)
03-26-2004	Mail Notice of Allowance		
03-22-2004	Issue Revision Completed		
03-22-2004	Notice of Allowance Data Verification Completed		
03-22-2004	Case Docketed to Examiner in GAU		
03-22-2004	Notice of Allowability		
01-08-2004	IFW Amended case processing Complete		
01-08-2004	Date Forwarded to Examiner		
12-04-2003	Response after Non-Final Action		34
12-04-2003	Request for Extension of Time - Granted		↑
07-11-2003	Electronic Information Disclosure Statement		↑
07-31-2003	Mail Non-Final Rejection	252	↑
07-14-2003	Non-Final Rejection	↑	
10-17-2002	Information Disclosure Statement (IDS) Filed	↑	
10-17-2002	Case Docketed to Examiner in GAU	↑	
01-04-2002	Information Disclosure Statement (IDS) Filed	↑	
04-16-2002	Incoming Letter Pertaining to the Drawings	↑	
01-04-2002	Information Disclosure Statement (IDS) Filed	↑	
10-17-2002	Date Forwarded to Examiner	↑	
01-31-2002	Fee Payment Recorded (fees filed separately e.g. not with original papers, etc).	↑	
01-31-2002	Oath or Declaration Filed (Including Supplemental)	↑	
06-03-2002	Transfer Inquiry to GAU	↑	
05-17-2002	Application Dispatched from OIPE	↑	
05-07-2002	Application Is Now Complete	↑	108
04-16-2002	Additional Application Filing Fees	↑	↑

04-16-2002	Applicant has submitted new drawings to correct Corrected Papers problems	↑	↑
01-31-2002	Payment of additional filing fee/Preexam	↑	↑
01-31-2002	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic	↑	↑
01-31-2002	Applicant has submitted new drawings to correct Corrected Papers problems	↑	↑
10-19-2001	Notice Mailed--Application Incomplete--Filing Date Assigned	↑	↑
10-19-2001	Correspondence Address Change	↑	
09-27-2001	IFW Scan & PACR Auto Security Review	↑	
09-21-2001	Initial Exam Team nn	↑	



APPENDIX B

A copy of the return receipt postcard that accompanied the substitute drawings submitted in the Response to the Notice of Incomplete Reply



- () Transmittal Letter
() PATENT APPLICATION & Friedrich Pgs.
() Specification (incl. Claims if any)
() Abstract of Disclosure
() Information Disclosure Statement
() Patent Copies
() Declaration & Power of Attorney
() Declaration Claiming Small Entity Status
() Assignment and Cover Sheet
(X) Drawings 10 Sheets
(X) Response to Missing Parts Notice
() Response to Office Action/Amendment
() Request for Ext. of Time for filing
() Issue Fee Transmittal
() Formal Drawings _____ Sheets
() Maintenance Fee Transmittal
() Fee Amount \$ _____ Check No. _____
() Fee Amount \$ _____ Check No. _____

(X) Other (Specify) Copy of Notice of
Incomplete Reply (Nonprovisional)

Inventor: Pikula, et al.

Title: WIRELESS SYNCHRONOUS TIME SYSTEM

(X) Serial/Patent No. 09/960,638

Due Date: 04/19/2002 Mail Date: 04/08/2002

File No.: 077017-9006-US001 Attorney: TMK/TSR

